

REMARKS

The Applicants have studied the Office Action dated October 4, 2005 and have made amendments to independent claims 20, 26, and 32 to distinctly claim and particularly point out the subject matter which the Applicants regard as the invention. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 20-37 are pending. Applicants submit that the present response and amendment places the application in condition for allowance. Entry of the present response with amendment is therefore respectfully requested.

In the Office Action, the Examiner:

- rejected claims 20, 26, and 32 under 35 U.S.C. §112, first paragraph;
- rejected claims 20-21, 24, 26, 27, 30, 32, 33, and 36 under 35 U.S.C. § 102(e) as being anticipated by, or alternatively, under 35 U.S. C. 103(a) as obvious over Mahajan et al. (U.S. 6,226,650 B1);
- rejected claims 22-23, 28-29, and 34-35 under 35 U.S.C. § 103(a) as being unpatentable Mahajan et al. (U.S. 6,226,650 B1) in view of Applicant Admitted Prior Art (Background);
- rejected claim 25 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) and Applicant Admitted Prior Art (Background) as applied to claim 24 above, and further in view of Rackman (U.S. 5,903,646); and
- rejected claims 31 and 37 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) in view of Rackman (U.S. 5,903,646).

ARC920010031US1

8

10/044,646

Rejection Under 35 USC § 112, Second Paragraph

As noted above, the Examiner rejected claims 20, 26, and 32 under 35 U.S.C. §112, first paragraph. In particular, the Examiner states on page 7 of the present Office Action that page 13, lines 9-22; page 6, lines 22-30 as recited by the Applicants in the previous Response With Amendment, do not sufficiently support the claimed features of:

searching for at least one database record in the first database with a value in the work history field matching a predetermined value,

using a sequence value within the sequence number field in the at least one data record in the first database with the value in the work history field matching the predetermined value as a starting point for synchronization with the remote database server...

appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value

The Applicants respectfully traverse this rejection. The following is a table with each claim element and the support in the specification and drawings of the original application as filed. No New matter has been added.

CLAIM ELEMENT	SUPPORT
<i>searching for at least one database record in the first database <u>with a value in the work history field matching a predetermined value</u>,</i>	In FIG. 6 column 606 the field WORK_HISTORY, specifically items 614 and 618, "COPY IN SYSTEM #N" of this example. Page 14, lines 1-14. FIG. 8 items 806 and 808 and page 17, lines 9-18.
<i>using a sequence value within the sequence number field in the at least one data record in the first database <u>with the value in the work history field matching the predetermined value</u> as a starting point for</i>	In FIG. 6 columns 602 the field WORK_ID contains a sequence number as shown along with column 606 the field WORK_HISTORY, specifically items 616 and 618, of this example. Page 14, lines 1-

ARC920010031US1

9

10/044,646

<i>synchronization with the remote database server [...]</i>	14. FIG. 8 items 806 and 808 and page 17, lines 9-18.
<i>appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value</i>	In FIG. 6 column 606 the field WORK_HISTORY, specifically items 661 618, "COPY IN SYSTEM #N" of this example. Page 14, line 6 and page 15 lines 2-3. FIG. 8 items 806 and 808 and page 17, lines 19-25.

The Applicants respectfully submit that the Examiner's rejection has been overcome and the rejection of claims 20, 26, and 32 should be withdrawn.

Rejection under 35 U.S.C. §102(e) or alternatively 103(a)

As noted above, the Examiner rejected claims 20-21, 24, 26-27,30, 32-33, and 36 under 35 U.S.C. § 102(e) as being anticipated by Mahajan et al. (U.S. 6,226,650 B1) or alternatively under 35 U.S.C. § 103(a) as obvious over Mahajan et al. (U.S. 6,226,650 B1). Independent claims 20, 26, and 32 have been amended to distinguish over Mahajan. Specifically, Mahajan is silent on:

selecting at least one remote database server;

accessing locally on a first database server, at least one database record in a first database, wherein the database record includes at least one field for each of a sequence number field, a problem identifier field, and a work history field;

searching for at least one database record in the first database, with a value in the work history field matching a predetermined value;

using a sequence value within the sequence number field in the at least one database record in the first database, with the value in the work history field matching the predetermined value as a starting point for synchronization with the remote database server, wherein the sequence value in the sequence number

field of the at least one database record is associated with the at least one database record;

sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value, wherein data included in each database record is new and distinct over existing information residing in the remote database server;

appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value; and

storing a new sequence number directly in a sequence number field of the at least one new database record in the first database, wherein the new sequence number is an increment of a final sequence number of a final database record sent to the remote database.

The term "new and distinct" is used as known in the art and was not *ipsis verbis* (not in the identical words) in the specification. The Examiner is respectively reminded that this was sufficiently described in the specification as found on page 12, lines 9-22, page 14, lines 13-14. No New matter has been added.¹

The Examiner concludes that Mahajan teaches:

"searching for at least one database record in the first

¹ If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. See *In re Alton* (Fed. Cir 1996) (Emphasis Added). See also *Fujikawa v. Wattanasin* (Fed. Cir. 1996), *ipsis verbis*, "as the Board recognized, however, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). See MPEP 2163 subsection II 3 (a), second to last paragraph.

database, with a value in the work history field matching a predetermined value"

The Examiner states on page 9 of the present Office Action that Mahajan discloses "modification files is analyzed to determine what data from the modification file 86 should be filtered, merged, deleted for synchronization (Col. 10, lines 14-29). In order to filter data for synchronizing, Mahajan further discloses the step of *searching for at least one data record in the first database with client ID as a value in the work history field matching client ID of the client computer system 12 as a predetermined value at FIG. 5B, Col. 10, Lines 19-35)*"

The Examiner asserts on page 4 that the modification files of Mahajan are analogous to the "first database" as recited for claims 20, 26, and 32. The Applicants repeat their arguments in the previous Office Action that the modification files are not analogous to the "first database", as recited for the present invention. The analyzing of the modification files, as stated by the Examiner on page 9 of the present Office Action, is performed by the client system, not by the database server. The present invention, on the other hand, recites a "method on a first database server" and performs all of the claim elements at the first database server. Furthermore, the Examiner states that the client ID of Mahajan is analogous to the "value in the work history field". Stated differently, the Examiner explicitly states on page 4 of the present Office Action that a work history field in Mahajan is the "transaction field that includes operation". The client ID 416 is just that, a client ID and is not a value in a work history field. A work history field, according to one embodiment of the present invention, is a field that includes "descriptions and notes of the work performed by a customer service representative during the life of a particular user problem". See the Specification as originally filed at page 12, lines 27 to page 13, lines 1-2. The Applicants respectfully suggest that the Examiner is arbitrarily and conveniently labeling the client ID of Mahajan as a work history field to support his assertions, when in fact, nowhere does Mahajan teach that the client ID is a value in a work history field. Therefore, the present invention distinguishes over Mahajan for at least these reasons.

The Examiner also concluded that Mahajan teaches:

"sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value".

The Applicants have amended claims 20, 26, and 32 to more clearly and distinctly recite:

"sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value, wherein data included in each database record is new and distinct over existing information residing in the remote database server"

Support for the above amendment may be found in the Specification as originally filed. See for example, page 12, lines 9-22, page 14, lines 10-14, page 15, lines 12-14, and page 17, lines 9-18. No new matter was added.

Mahajan explicitly teaches that modification files are sent to client systems and can include data already existing on the client system. In other words, duplicated data is sent. For example, see Mahajan at Abstract; col. 3, lines 6-9; col. 4, lines 26-29 and lines 39-42; col. 8, lines 35-37; col. 10, lines 33-35; and FIGs. 5B-5C. Furthermore, as the citations given by the Examiner on page 9 of the present Office Action show, the client system analyzes the received modification files to filter out data in the modification files it already has. See Mahajan generally at Id.

In contrast, one of the advantages of the present invention is that by using a sequence value with the value in the work history field matching the predetermined value as a starting point for synchronization, duplicated data will not be transmitted. The present

invention recites "sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value , wherein data included in each database record is new and distinct over existing information residing in the remote database server". In other words, the data in the database records transmitted by the first database server do not include information already existing at the client system. Therefore, the present invention distinguishes over Mahajan for at least these reasons as well.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Mahajan is the use of local filtering because the data received by the client may be duplicate, in contrast the intent and purpose of the present invention is "new and distinct". Not only does the present invention eliminate the need to perform local filtering, the present invention reduced bandwidth by transmitting "new and distinct" data. This combination, as suggested by the Examiner, destroys the intent and purpose of Mahajan use of local filtering at the client to eliminate duplicate records. Accordingly, the present invention is distinguishable over Mahajan for this reason as well.

The Examiner also concluded that Mahajan teaches:

"appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value"

Applicants respectfully disagree with the Examiner's conclusion that Mahajan teaches the above claim element. As discussed above, the client ID is not a value in a work history field. Once again the Applicants respectfully suggest that the Examiner is

arbitrarily and conveniently labeling the client ID as a value in a work history. Mahajan fails to even suggest that the client ID is in a work history field. The citations given by the Examiner fail to support this assertion. Therefore, Mahajan does teach, anticipate, or suggest "appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value". Accordingly, the present invention distinguishes over Mahajan for at least these reasons as well.

Because the elements in independent claims 20, 26, and 32 of:

[...]

searching for at least one database record in the first database, with a value in the work history field matching a predetermined value; [...]

sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value, wherein data included in each database record is new and distinct over existing information residing in the remote database server

appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value"

are not taught or disclosed by Mahajan, Mahajan does not identically describe each and every element of claims 20, 26, and 32. Accordingly, claims 20, 26, and 32 distinguish over Mahajan for at least these reasons. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) or alternatively under 35 U.S.C. § 103(a) as obvious over Mahajan et al. (U.S. 6,226,650 B1) with respect to claims 20, 26, and 32 has been overcome and the rejection should be withdrawn.

Additionally, claims 21, 24, 27, 30, 33, and 36 depend from claims 20, 26, and 32 respectively and, since dependent claims recite all of the limitations of the independent

claim; it is believed that, therefore, claims 21, 24, 27, 30, 33, and 36 also recite in allowable form. Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 20-21, 24, 26-27, 30, 32-33, and 36 under 35 U.S.C. § 102(e) or alternatively under 35 U.S.C. § 103(a) as obvious over Mahajan et al. (U.S. 6,226,650 B1) has been overcome. Applicants request that the Examiner allow claims 20-21, 24, 26-27, 30, 32-33, and 36.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art

As noted above, the Examiner rejected claims 22-23, 28-29, and 34-45 under 35 U.S.C. § 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) in view of Applicant Admitted Prior Art (Background). The Examiner goes on to combine Mahajan with the Admitted Prior Art found in the Background section of the Specification as originally filed.² In particular, the Examiner states that Mahajan fails to disclose "the database record is sent for customer service information. The Examiner further states that the background of the disclosure "a help desk application for customer service [and] [t]herefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Mahajan method by using the technique as discussed for storing customer service information in order to maintain synchronization among a server and a help desk client". The Applicants respectfully disagree with the Examiner's assertions.

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." As described in the section entitled "Rejection under 35 U.S.C. §102(e) or alternatively 103(a)" and for brevity will not be repeated here. The Mahajan reference taken alone or in view of the Admitted Prior Art simply does not teach, anticipate, or suggest the patentably distinct

² Applicants make no statement whether such combination is even proper.

limitation of:

[...]

searching for at least one database record in the first database, with a value in the work history field matching a predetermined value; [...]

sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value, wherein data included in each database record is new and distinct over existing information residing in the remote database server

appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value"

The limitations taken "as a whole" in independent claims 20, 26, and 32 are not present in Mahajan taken alone or in view of the Admitted Prior Art. Accordingly, the present invention is distinguishable over Mahajan in view of the Admitted Prior Art for at least this reason.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Mahajan is the use of local filtering because the data received by the client may be duplicate, in contrast the intent and purpose of the present invention is "new and distinct". Not only does the present invention eliminate the need to perform local filtering, the present invention reduced bandwidth by transmitting "new and distinct" data. This combination, as suggested by the Examiner, destroys the intent and purpose of Mahajan use of local filtering at the client to eliminate duplicate records. Accordingly, the present invention is distinguishable over Mahajan for this reason as

well and the Examiner's case of "*Prima Facie Obviousness*" should be withdrawn.

Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 22-23, 28-29, and 34-45 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claims 22-23, 28-29, and 34-45.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art
in further view of Rackman

As noted above, the Examiner rejected claim 25 under 35 U.S.C. 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) and Applicant Admitted Prior Art (Background) as applied to claim 24 above, and further in view of Rackman (U.S. 5,903,646). The Examiner goes on to combine Mahajan with the Applicant Admitted Prior Art in further view of Rackman.³ In particular, the Examiner states that Mahajan fails to disclose "the database record from the first database server with the first database schema that has been previously designated as non-confidential". The Examiner further states that Rackman discloses "a technique of designating a document as confidential and non-confidential (Rackman, Col. 3, Line 57- Col. 4, Line 40) [and] [t]herefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to designate a document as non-confidential and confidential in order to secure access to a database". The Applicants respectfully disagree with the Examiner's assertions.

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Mahajan reference taken alone or in view of the Admitted Prior Art or Rackman simply does not teach, anticipate, or suggest the patentably distinct claim elements of independent claim 20,

³ Applicants make no statement whether such combination is even proper.

which have been discussed above in the section entitled "Rejection under 35 U.S.C. §102(e) or alternatively 103(a)" and for brevity will not be repeated here.

Rackman discloses an access control system for litigation document production. See Rackman at Abstract. Nowhere does Rackman teach the presently claimed invention as recited for claim 1. Therefore, the limitations taken "as a whole" in independent claim 20 and accordingly claim 25, which depends from claim 20, are not present in Mahajan taken alone or in view of the Applicant Admitted Art and further in view of Rackman.

Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claim 25 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claim 25.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Rackman

As noted above, the Examiner rejected claims 31 and 37 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) in view of Rackman (U.S. 5,903,646). The Examiner goes on to combine Mahajan with Rackman.⁴ In particular, the Examiner states that Mahajan fails to disclose "the database record from the first database server with the first database schema that has been previously designated as non-confidential". The Examiner further states that Rackman discloses "a technique of designating a document as confidential and non-confidential (Rackman, Col. 3, Line 57-Col. 4, Line 40) [and] [t]herefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to designate a document as non-confidential and confidential in order to secure access to a database". The Applicants respectfully disagree with the Examiner's assertions.

⁴ Applicants make no statement whether such combination is even proper.

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Mahajan reference taken alone or in view of Rackman simply does not teach, anticipate, or suggest the patentably distinct claim elements of independent claims 26 and 32, which have been discussed above in the section entitled Rejection under 35 U.S.C. §102(e) or alternatively 103(a)" and for brevity will not be repeated here. Therefore, the limitations taken "as a whole" in independent claims 26 and 32 and accordingly claims 31 and 37, which depend from claims 26 and 32, are not present in Mahajan taken alone or in view of Rackman.

Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 31 and 37 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claims 31 and 37.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

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20

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Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

Date: January 4, 2006

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ARC920010031US1

21

10/044,646